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EXAMINER
FRENEL, VANEL

ART UNIT	PAPER NUMBER
3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No. 09/666,445	Applicant(s) OLSON ET AL.
	Examiner Vanel Frenel	Art Unit 3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _29 June 2004_.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _1,3-10,12,15-17,19-25,27-31,33-37 and 39-42_ is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _1,3-10,12,15-17,19-25,27-31,33-37 and 39-42_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Notice to Application

1.   This communication is in response to the Amendment filed 06/29/04. Claims 1, 3-

10, 12, 15-17, 19-25, 27-31, 33-37 have been amended. Claims 2, 13-14, 22, 26, 32

and 38 have been canceled. Claims 39-42 have been added. Claims 1, 3-10, 11,12, 15-

17, 18, 19-25, 27-31, 33-37 and 39-42 are pending.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

3.   Claims 1, 3-10, 12, 15-17, 19-25, 27-31, 33-37 and 39-42 are rejected under 35

U.S.C. 103(a) as being unpatentable over Lavin et al (5,772,585) in view of Pross et al

(5,343,869), for substantially the same reasons given above in the previous Office

Action. Further reasons appear hereinbelow.

(A)   As per the added features to claim 1, Lavin discloses "medical", "accessing

patient data" "for at least one" "from a patient storage module (Col.9, lines 65-67 to

Col.10, line 41), the accessed patient data being accessed to assist in the medical care

of the at least one patient" (See Lavin, Col.8, lines 34-67); (b) "accessing updateable

rules and parameters that correspond to one or more medical conditions, the accessed

updateable rules and parameters being accessed from a medical knowledge module to

assist in at least identifying the one or more medical conditions in the at least one

patient (See Lavin, Col.8, lines 11-58; Col.9, lines 65-67 to Col.10, line 41);" c)

"generating" " the at least one" "based on the accessed patient data and the accessed

updateable rules and parameters (See Lavin, Col.8, lines 11-58; Col.9, lines 65-67 to

Col.10, line 41)".

Lavin does not explicitly disclose d) "transferring the generated decision-

supported patient data to" "such that" "can be presented", "the at least one", "the at least

one".

However, this feature is known in the art, as evidenced by Pross. In particular,

Pross suggests "transferring the generated decision-supported patient data to" "such

that" "can be presented", "the at least one", "the at least one" (See Pross, Col.6, lines

13-67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the feature of Pross within the system of Lavin with the

motivation of providing a system able to store the vital signs information (See Pross,

Col.3, lines 12-13).

The remaining features are as addressed in the previous Office Action, and

incorporated herein.

(B)   As per the added features to claim 3, Pross discloses "transferring the generated

decision-supported patient data to the mobile user module comprises transferring the

generated decision-supported patient data such that relevant", "for the at least one",

"can be stored", "mobile" (Col.6, lines 13-68).

The remaining features are as addressed in the previous Office Action, and

incorporated herein.

(C)   As per the added features to claim 4, Pross discloses "transferring the generated

decision-supported patient data to the mobile user module comprises transferring the

generated decision-supported patient data such that" "can be presented" (Col.6, lines

13-44).

The remaining features are as addressed in the previous Office Action, and

incorporated herein.

(D)   Claim 5 was apparently amended to include the words "medical", rules and

parameters for diagnosing medical conditions". However, these changes do not affect

the scope and the breadth as originally presented /or in the manner the claim was

interpreted by the Examiner when applying prior art within the previous Office Action. As

such, this claim is rejected under the same reason given in the prior Office Action, and

incorporated herein.

The remaining features are as addressed in the previous Office Action, and

incorporated herein.

(E)   As per the added features to claim 6, Lavin discloses "generating decision-supported patient data" "the steps of", "a", "the accessed patient data", "corresponding to the"; "applying the accessing updateable rules and parameters to the patient data corresponding to the patient to assist the clinician in determining if the patient has any of the corresponding one or more medical conditions" (See Lavin, Col.8, lines 11-58; Col.9, lines 65-67 to Col.10, line 29).

(F)   Claim 7 was apparently amended to include the words "the steps of". However, these changes do not affect the scope and the breadth as originally presented /or in the manner the claim was interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(G)   Claim 8 was apparently amended to include the words "generating decision-supported patient data", "accessed" ". However, these changes do not affect the scope and the breadth as originally presented /or in the manner the claim was interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(H)   As per the added features to claim 9, Pross discloses "wherein the step for accessing updateable rules and parameters", "comprises", "accessing rules and parameters used to automatically generate one of a computerized medical condition diagnosis and computerized medical care recommendation" (Col.7, lines 47-67; Col.11, lines 12-55).

(I)   As per the added features to claim 10, Lavin discloses "accessing patient data that was previously received from the mobile user module" (See Lavin, Col.8, lines 34-67).

(J)   As per the added features to claim 12, Lavin discloses "In a medical decision-support system", "mobile", "accessing' "from a patient storage module (Col.9, lines 65-67 to Col.10, line 41), the accessed patient data to assist in the medical care of at least one (See Lavin, Col.8, lines 34-67)", "program code means for accessing updateable rules and parameters corresponding to one or more medical conditions, the accessed updateable rules and parameters being accessed from a medical knowledge module to assist in at least identifying the one or more medical conditions in the at least one patient (Col.8, lines 34-67).

Lavin does not explicitly disclose "generating", "the at least one", "based on the accessed patient data and the accessed updateable rules and parameters", "transferred", "the mobile user"; and "transferring the generated", "to the mobile user module such", "can be presented with decision-supported patient data", "the at least one".

However, this feature is known in the art, as evidenced by Pross. In particular, Pross suggests "generating", "the at least one", "based on the accessed patient data and the accessed updateable rules and parameters", "transferred", "the mobile user"; and "transferring the generated", "to the mobile user module such", "can be presented with decision-supported patient data", "the at least one" (See Pross, Col.6, lines 13-57).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Pross within the system of Lavin with the motivation of providing a system able to store the vital signs information (See Pross, Col.3, lines 12-13).

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(K)   Claim 15 was apparently amended to include the words "the at least one", "mobile". However, these changes do not affect the scope and the breadth as originally presented /or in the manner the claim was interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(L)   Claim 16 was apparently amended to include the words "rules and parameters for diagnosing medical conditions". However, these changes do not affect the scope and the breadth as originally presented /or in the manner the claim was interpreted by· the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(M)   As per the added features to claim 17, Lavin discloses "generating decision-supported patient data", "a", "accessed", "patient", "corresponding to the", "applying the accessing updateable rules and parameters to the patient data corresponding to the patient to assist the clinician in determining if the patient has any of the corresponding one or more medical conditions" (See Lavin, Col.8, lines 11-58; Col.9, lines 65-67 to Col.10, line 41).

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(N)   Claim 19 was apparently amended to include the words "generating decision-

supported patient data", "accessed". However, these changes do not affect the scope

and the breadth as originally presented /or in the manner the claim was interpreted by

the Examiner when applying prior art within the previous Office Action. As such, this

claim is rejected under the same reason given in the prior Office Action, and

incorporated herein.

The remaining features are as addressed in the previous Office Action, and

incorporated herein.

(O)   As per the added features to claim 20, Lavin discloses " wherein program code

means for accessing updateable rules and parameters comprises program code means

for accessing rules and parameters used to automatically generate one of a

computerized medical condition diagnosis and a computerized medical care

recommendation (Col.8, lines 34-67).

(P)   As per the added features to claim 21, Lavin discloses "accessing patient data",

"accessing patient data that was previously received from the mobile user module"

(Col.8, lines 34-67).

(Q)   As per the added features to claim 23, Lavin discloses "updateable rules and

parameters accessed from a knowledge module, the updateable rules and parameters

corresponding to one or more medical conditions", "received", " the at least one", "the at least one" (See Lavin, Col.8, lines 34-67).

Lavin does not explicitly disclose "medical", "accessing", "at", indicating", "receiving decision-supported patient", "corresponding to", "from", "the decision-supported patient data having been generating by", "along".

However, this feature is known in the art, as evidenced by Pross. In particular, Pross suggests "medical", "accessing", "at", indicating", "receiving decision-supported patient", "corresponding to", "from", "the decision-supported patient data having been generating by", "along" (See Pross, Col.6, lines 13-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Pross within the system of Lavin with the motivation of providing a system able to store the vital signs information (See Pross, Col.3, lines 12-13).

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(R)   As per the added features to claim 24, Lavin discloses "medical", "accessing patient data for at least one patient from a patient storage module to assist in the medical care of the at least one patient" (Col.9, lines 65-67 to Col.10, line 41); (b) "access updateable rules and parameters corresponding to one or more medical conditions, the accessed updateable rules and parameters being accessed to assist in

at least identifying the one or more medical conditions in the at least one patient (See

Lavin, Col.8, lines 34-67).

Lavin does not explicitly disclose c) "for the at least one" "based on the accessed

patient data and the accessed updateable rules and parameters" and d) "transfer the

generated decision-supported patient data to the mobile user module, such that the

clinician can be presented with decision-supported patient data for the at least one

patient in a configuration that assists the clinician in treating the at least one patient";

"and ", "receive decision-supported patient data from", "present", "the at least one".

However, these features are known in the art, as evidenced by Pross. In

particular, Pross suggests c) "for the at least one" "based on the accessed patient data

and the accessed updateable rules and parameters" and d) "transfer the generated

decision-supported patient data to the mobile user module, such that the clinician can

be presented with decision-supported patient data for the at least one patient in a

configuration that assists the clinician in treating the at least one patient"; "and ",

"receive decision-supported patient data from", "present", "the at least one" (See Pross,

Col.6, lines 13-67).

It would have been obvious to one of ordinary skill in the art at the time of the

invention to have included the feature of Pross within the system of Lavin with the

motivation of providing a system able to store the vital signs information (See Pross,

Col.3, lines 12-13).

The remaining features are as addressed in the previous Office Action, and

incorporated herein.

(S)   Claim 25 was apparently amended to include the words "medical decision-support", medical knowledge". However, these changes do not affect the scope and the breadth as originally presented /or in the manner the claim was interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(T)   Claim 27 was apparently amended to include the words "medical decision-support", medical knowledge". However, these changes do not affect the scope and the breadth as originally presented /or in the manner the claim was interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(U)   Claim 28 was apparently amended to include the words "medical decision-support" "decision-support". However, these changes do not affect the scope and the breadth as originally presented /or in the manner the claim was interpreted by the

Examiner when applying prior art within the previous Office Action. As such, this claim is

rejected under the same reason given in the prior Office Action, and incorporated

herein.

The remaining features are as addressed in the previous Office Action, and

incorporated herein.

(V)   As per the added features to claim 29, Lavin discloses "medical decision-

support", "knowledge" "is updateable as more recent medical knowledge corresponding

to the one or more medical conditions becomes available" (Col.8, lines 9-67).

(W)   As per the added features to claims 30-31 and 34-35, Lavin discloses "medical

decision-support" (Col.).

(X)   Claim 33 was apparently amended to include the words "medical decision-

support" "module". However, these changes do not affect the scope and the breadth as

originally presented /or in the manner the claim was interpreted by the Examiner when

applying prior art within the previous Office Action. As such, this claim is rejected under

the same reason given in the prior Office Action, and incorporated herein.

The remaining features are as addressed in the previous Office Action, and

incorporated herein.

(Y)   Claims 36-37 were apparently amended to include the words "medical decision-support" "knowledge". However, these changes do not affect the scope and the breadth as originally presented /or in the manner the claim was interpreted by the Examiner when applying prior art within the previous Office Action. As such, this claim is rejected under the same reason given in the prior Office Action, and incorporated herein.

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(Z)   As per claim 39, Lavin discloses the method wherein the step of presenting received decision-supported patient data comprises a step of presenting received decision support data via a user interface wherein the user interface comprises one or more of a graphical user interface, an interactive user interface, a voice recognition user interface, and a textual user interface (See Lavin, Col.5, lines 7-46; Col.11, line 48-67).

(AA)   As per claim 40, Lavin discloses the method wherein the user module is mobile user module (See Lavin, Col.4, lines 43-67).

(BB)   As per claim 41, Lavin discloses the method wherein the accessed updateable rules are configured to be updated when more recent medical knowledge corresponding to the one or more medical conditions becomes available (Col.8, lines 9-67).

(CC)   As per claim 42, Lavin discloses the method wherein the accessed updateable

rules are configured to be updated when more recent medical knowledge corresponding

to the one or more medical conditions becomes available (Col.8, lines 9-67).

(DD)   Claims 11 and 18have not been amended and are therefore rejected for the

same reasons given in the previous Office Action, are incorporated herein.

Response to Arguments

4.   Applicant's arguments filed on 06/29/04 with respect to claims 1, 3-10, 12, 15-17,

19-25, 27-31, 33-37 and 39-42 have been fully considered but they are not persuasive.

Applicant's arguments will be addressed hereinbelow in which they appear in the

response filed on 06/29/04.

(A)   At pages 19-21 of the 06/29/04 response, Applicant argues the followings:

      (1) Lavin and Pross fail to disclose "accessing patient data for at least one

patient, accessing updateable rules and parameters corresponding to one or more

medical conditions, generating–decision-supported patient data for at least one patient

based on the accessed patient data and the accessed updateable rules and

parameters, and transferring the generated decision-supported patient data to the

mobile user mobile".

      (2) Lavin and Pross fail to disclose a decision support module configured to

implement the method of claim 1 along with a remotely located user module configured

to receive decision-supported patient data from the decision-support module.

(3) Lavin and Pross fail to disclose at least one patient, receiving decision-support patient data having been generating by evaluating patient accessed from a patient module along with updateable rules and parameters corresponding to one or more medical conditions; and presenting received decision-support patient data specific to the at least one patient in a configuration that assists a clinician in treating the at least one patient.

(4) Lavin and Pross fail to anticipate or obviate the recited claims either singly or in combination.

(B)   With respect to Applicant's first argument, Examiner respectfully submits that Lavin suggests "the tables and relationships for the patient information screens shown in FIGS.5-7 are shown in FIG.23. As shown by the pointing relationships between the Patient Information table ("Patient Infor") 354 and the radially outlying tables 304, 332, 326, 334, 336, 378, 312 and 324. The Patient Information table 354 thus points to several other tables, thus allowing a variety of types of information to be retrieved by patient information such as patient name or number (See Lavin, Col.14, lines 66-67 to Col.15, line 12) which correspond to Applicant's claimed feature. Therefore, Applicant's argument is non-persuasive.

Furthermore, Examiner notes that Lavin suggests in FIG. 11 a patient history screen having a past medical history display 100 and habits display 102. Each of these screens is associated with a Procedure History ("Proc-Hist") table 358 and a "Habits" table 334, respectively. Associated with the Procedure History table 358 is a Diagnosis

History table 312 ("Diag- Hist") (tables shown in FIGS. 21-24). Each of these tables is

associated with a list table to provide a customized list of procedures or diagnoses. In

particular, the "Custom- P List" table 310 and the "Custom- D List" 308 are associated

with the above history tables, respectively. The past medical history segment of the

screen 102 preferably permits a user to view past diseases in a disease list 104

(associated with the Diagnosis History table 312) that displays diseases previously

suffered by the patient in terms of date and disease name. To aid the user in selecting

and entering diseases in the past medical history list a possible disease list 106

associated with "Custom- D List" 308 is available for use within the past medical history

display 100. As a user types in a particular illness or surgery in a dedicated text box

108, a type-ahead function will display diseases on the disease list 106 as more

characters are typed into the text box 108. A date entry box 110 is also positioned on

the past medical history screen to associate the selected illness or surgery with a

particular date after which the user may add or remove the selected illness or procedure

to the disease list. The patient's habits display 102 is broken down into separate text

entry areas for typical medically significant habits such as smoking, coffee drinking,

alcohol consumption and exercise habits. Family history is also important in any

physician's diagnosis of a patient. Once the patient's medical history background has

been updated or entered, a nurse attending to the patient prior to the physician's

examination will record the patient's vital signs. A nurse, or other medical practitioner,

may enter the vital statistics on a vital statistic entry screen 122 as shown in FIG. 12.

This screen is identical to that shown in FIG. 16C, but reproduced at this point in the

program to increase speed. The vital statistics, which will be stored in "Vitals" table 378 (shown in FIGS. 21-24) by patient name and date, include height 124, weight 126, temperature 128, pulse 130 and respiration 132. Text entry areas for blood pressure measured supine 134 and sitting 136 are also included. The nurse can also enter a patient's chief complaint in a text box 138 to update and clarify any earlier provided reasons for the visit that were recorded in the appointment scheduling screens at that time the patient made the appointment. The nurse will also review any drug allergy or other allergy information that the patient is aware of and enter those in dedicated text areas 140, 142 on the vital statistics interface 122. An important aspect of the presently preferred method is the ability for a physician to use a work station 14, either fixed or portable, to enter data, view patient history, and record diagnoses during the examination. At the beginning of the day when using a portable work station 14, or at a fixed work station in a examination room prior to a specific examination, a physician may select from the main menu screen 28 a clinical button 34 to access the clinical examination module. As best shown in FIG. 13, the physician first accesses the clinical module and then enters a password (at steps 150, 152). The password requirement ensures that only the proper personnel have access to patient information at the level permitted in the clinical module (See Lavin, Col.8, lines 9-67).

(C)   In response to Applicant's second argument, Examiner respectfully submits that Pross suggests patient information is transmitted from the remote computer to the portable electronic data acquisition unit. That is, the patient's name, his clinical history,

an administrative number assigned to the patient, his health insurance or related data

may be "uploaded" from the remote system to the portable electronic data acquisition

unit. The nurse may recall this information at any point in time as she is making her

round. A patient identifier is particularly helpful if vital signs of a multiplicity of patients

are to be collected. In this case, the nurse may recall the prestored patient identifier

prior to data acquisition, such that the vital signs information is correctly assigned to a

particular patient. This may be done by a simple keystroke. Another keystroke may

cause the portable electronic data acquisition unit to store the vital signs information of

the patient (See Pross, Col.6, lines 45-62) which correspond to Applicant's claimed

feature. Therefore, Applicant's argument is non-persuasive.

(D)   With respect to Applicant's third argument, Examiner respectfully submits that

Lavin suggests "As best shown in FIG. 13, the physician first accesses the clinical

module and then enters a password (at steps 150, 152). The password requirement

ensures that only the proper personnel have access to patient information at the level

permitted in the clinical module. After entering the password, the display 24 on the work

station 14 produces a patient record screen through which the physician enters a

patient's name to obtain the appropriate patient's information (at step 154)" which

correspond to Applicant's claimed feature (See Lavin, Col.8, line 67 to Col.9, line 8).

Therefore, Applicant's argument is not persuasive.

(E)   With respect to Applicant's fourth argument, Examiner respectfully submits

that obviousness is not determined on the basis of the evidence as a whole and the

relative persuasiveness of the arguments. See *In re Oetiker*, 977F. 2d 1443, 1445,24

USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783F.2d 1038, 1039, 228 USPQ

685, 686 (Fed. Cir.1992); *In re Piaseckii*, 745 F.2d 1468, 1472, 223 USPQ 785, 788

(Fed. Cir.1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA

1976). Using this standard, the Examiner respectfully submits that he has at least

satisfied the burden of presenting a prima facie case of obviousness, since he has

presented evidence of corresponding claim elements in the prior art and has expressly

articulated the combinations and the motivations for combinations that fairly suggest

Applicant's claimed invention (See the previous Office Action). Note, for example, in the

instant case, the Examiner respectfully notes that each and every motivation to combine

the applied references are accompanied by select portions of the respective

reference(s) which specially support that particular motivation and /or an explanation

based on the logic and scientific reasoning of one ordinarily skilled in the art at the time

of the invention that support a holding of obviousness. As such, it is not seen that the

Examiner's combination of references is unsupported by the applied prior art of record.

Rather, it is respectfully submitted that explanation based on the logic and scientific

reasoning of one of ordinarily skilled in the art at the time of the invention that support a

holding of obviousness has been adequately provided by the motivations and reasons

indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300(Bd. Pat. App.&

Inter., 4/22/93). Therefore, the combination of references is proper and the rejection is

maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, In re Bozek, 163 USPQ 545 (CCPA 1969). Therefore, Applicant's argument is not persuasive.

Further, it is respectfully submitted that Applicant merely provides a piecemeal analysis of the teachings of the Lavin and Pross references, separately, and in a vacuum. As such, it is respectfully submitted that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, with specific reference to Applicant's remarks about the Lavin reference, the Examiner respectfully submits that it is sufficient to demonstrate that the prior art meets the limitations as claimed, whether by a single instance or scenario, or in every possible preferred embodiment, since it was determined in In re Lamberti et al, 192 USPQ 278 (CCPA) that:

    (i)   <u>obviousness does not require absolute predictability</u>;

    (ii)   <u>non-preferred embodiments of prior art must also be considered</u>; and

    (iii)   the question is not <u>express</u> teaching of references, but what they would suggest. Therefore, Applicant's argument is non-persuasive.

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Conclusion

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Vanel Frenel whose telephone number is 703-305-

4952. The examiner can normally be reached on Monday-Thursday form 6:30am-

5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers

for the organization where this application or proceeding is assigned are 703-305-7687

for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is 703-308-

1113.

$V\!F$
V.F

September 27, 2004

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600